

REMARKS

Claims 41-82 are pending. Claims 1-40 have been canceled and claims 41-82 have been added. The Examiner previously made a restriction requirement and during a telephone conversation with the Examiner on 5/1/03, a provisional election was made without traverse to prosecute the invention of Group 1 corresponding to claims 1-21 and 30-40. Applicant hereby affirms this election. Although claims 1-21 and 30-40 have been canceled, new claims 41-82 maintain consonance with the invention of Group 1. No new matter has been introduced. Reexamination and reconsideration of this application is respectfully requested.

In the May 09, 2003 Office Action, the Examiner rejected claims 1, 2, 5, 6, 8-11, 18, 19, 21, 30, 33, 34, and 36 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,329,994 to Gerver, et al. ("the Gerver Reference"). The Examiner rejected claims 7, 12, 17, 20, 35, 37, 39, and 40 under § 103(a) as being unpatentable over Gerver in light of the Examiner taking official notice that the claims are obvious. The Examiner rejected claims 3, 4, 13-16, 30-36 and 38 under §103(a) as being unpatentable over Gerver in view of U.S. Patent No. 5,937,392 to Alberts ("The Alberts reference"). These rejections are respectfully traversed.

Embodiments of the present invention are directed to a system of playing moving advertisements, such as commercials produced in a video format, over the Internet and other networks. A user accesses a content website, one that does not primarily provide advertising, such as CNN.com. In response to the loading of the page, a video-like electronic advertisement is launched on top of the content page, obscuring the content page so that the content page cannot be accessed while the advertisement is displayed. The advertisement runs and when the advertisement has reached an

ending time (i.e., the commercial is finished), the electronic advertisement will be removed from the display. About the time the commercial has completed its showing, information about the showing of the advertisement will be collected and sent to an advertisement play tracker for use in advertisement management and billing purposes. Claim 41 recites: A system for displaying an electronic advertisement having advertisement content, said system comprising:

a communication network;

a terminal having a display device, said terminal configured to receive data through said communication network;

an advertisement source configured to transmit an electronic advertisement to said terminal to be displayed on said display device through said communication network, *said electronic advertisement containing moving objects;*

a content source configured to transmit a main content and a play script to said terminal through said communication network, *said main content being content other than advertising; and*

an advertisement play tracker, configured to receive a play-tracking message indicating the electronic advertisement has been shown, wherein

execution of said play script by said terminal causes the electronic advertisement to be sent to the terminal, and *the play script sends a play tracking message to the advertisement play tracker around the ending time.*

Whereas the subject of the present application is electronic advertisements, the Gerver reference has nothing to do with advertising. The Gerver reference is directed to a method of producing an animation sequence on a graphic display driven by a computer, including defining an object that includes a geometrical description of an animated character and animating an image of the character responsive to the

characteristics. The character is programmed with a predetermined response, such as a rule governing motion of the character, to a sensitivity condition occurring externally to the object. The geometrical description of the object includes a geometrical skeleton characterized by a hierarchy of sub-objects connected by joints, the rule governing motion defines motion of the joints.

In the May 09, 2003 Office Action, the Examiner states that Gerver reference anticipates all the elements of claim 1. Applicant respectfully submits that the Gerver reference never anticipated claim 1, and that, in any case the Examiner's rejections are not applicable to new claim 41. First, and foremost, the Gerver reference never mentions an electronic advertisement as recited by canceled claim 1 and new claim 41. The word "advertisement" is not even in the specification. The word "advertising" appears only once, and that is in the sentence at column 28, lines 34-38: "It will be appreciated, however, that the principles of the present invention, as described with reference to the talk show, may similarly be applied to transmit other types of animated information, entertainment, and advertising programs over a network." That is the only time the word advertising is ever used in the entire Gerver reference. And if one looks to see what "the talk show" is, one will see that it has little to do with the present invention.

Furthermore, as applied to claim 41, the Gerver reference does not teach, suggest, or disclose: **an advertisement source** configured to transmit an electronic advertisement to said terminal to be displayed on said display device through said communication network, said electronic advertisement containing moving objects;

a content source configured to transmit a main content and a play script to said terminal through said communication network, said main content being content other than advertising;

an advertisement play tracker, configured to receive a play-tracking message indicating the electronic advertisement has been shown, wherein execution of said play script by said terminal causes the electronic advertisement to be sent to the terminal, and the play script sends a play tracking message to the advertisement play tracker about the ending time.

The Gerver reference does not teach, suggest, or disclose an advertisement source. The Gerver reference does not teach, suggest, or disclose a content source that transmits main content and a script to load an electronic advertisement. Finally, the Gerver reference does not teach, suggest, or disclose an advertising play-tracker that will send a tracking message indicating that the advertisement has been shown substantially through completion. The Gerver reference does not teach, suggest, or disclose any of these limitations, because the Gerver reference has nothing to do with advertising.

The Examiner also stated that the Gerver reference anticipates canceled claim 10. Claim 10 was a dependent claim wherein the terminal is configured to prevent user access to a portion of said first layer upon the display of said advertising content in said second display layer. New claim 46 is analogous to canceled claim 10 and is dependent on claim 41 wherein the electronic content is displayed on a first layer and the main content is displayed on a second layer and the display device is configured to display the first layer over a portion of the second layer to prevent access to the second

layer while the first layer is displayed on the display device. However, the Gerver reference teaches against this practice! The impetus behind making the content layer inaccessible while the electronic advertisement is displayed is to require people to view the electronic advertisement. The Gerver reference is directed to making the animation as non-imposing as possible and to still be able to utilize the content page. At column 6, lines 24- 26, the Gerver reference states: "The software application associated with the window preferably continues to operate while the Smart Object is running." At column 6, lines 31-35, the Gerver reference states: "Preferably the image element that is overlaid over the window obscures only the portion of the window immediately behind the element, while the remainder of the window is unobscured, **and the application associated with the window continues to function.**" Then again at column 10, lines 55-59, the Gerver reference states: "Preferably, **the substantially unrelated software application continues to run substantially as though the image element was not overlaid on the window**, and the only portion of the window obscured is the portion directly behind the image element on the graphic display." Thus, not only does the Gerver reference not anticipate claim 46, it substantially teaches against it.

The Examiner also rejected canceled claim 7, which recites the system of claim 1, further wherein said terminal is configured to remove said advertising content from display upon the occurrence of a removal triggering event as obvious in light of Gerver. Assuming the Examiner was correct in rejecting independent claim 1 as anticipated by Gerver (which applicant again respectfully denies), the Applicant grants that removal of the advertising content upon the occurrence of a removal-triggering event is obvious. However, applicant respectfully submits that the Examiner's further statement is not

obvious. The Examiner stated that "it would be obvious to one of ordinary skill at the time of the invention to have removed the animation when the animation is complete so that the user can then access the underlying main content otherwise inaccessible during the advertising animation." Dependent claim 82, which depends from independent claim 41, recites a limitation similar to the Examiner's statement. Dependent claim 82 recites the system of claim 41, *wherein the play script includes a timeline indicating an ending time of the electronic advertisement and causes the electronic advertisement to be removed from the display device at the ending time.* Applicant submits that this limitation is not obvious. First, as applied to the Gerver reference, the Gerver reference does not anticipate the animation being completed. The Gerver animation is to be interacted with and thus, some other removal-triggering event must occur (such as closing the program that runs the animation). Second, in regard to the field of advertising, (which as stated, Gerver has little to do with), advertisers do not want their ads to just disappear. The longer the ads are in view, the longer the user has exposure to those ads. Furthermore, requiring the user to close the window in which the ad is located gives the user even more exposure to the ad. Pop-up ads do not just disappear. Neither do banner ads.

The invention recited in the claims already ensures that the user will view and become connected with the ad (by not allowing the user to access the content page until the advertisement has finished playing, and by locking the advertisement on the screen so that the use cannot scroll past it (see argument below)). Thus, the present invention does not need to require the user make a pro-active movement to close the advertisement. By not requiring the user to make a pro-active movement, the

advertising company can further gather good-will by not requiring action out of the user. Thus, the removal of the advertisement from the display at the ending time is not obvious, yet still beneficial. Thus, the Applicant believes independent claim 41 overcomes the Examiner's rejections based on the Gerver reference.

Furthermore, if the Examiner still maintains that such a limitation is obvious, Applicant respectfully requests that the Examiner provide documentary evidence or other adequate evidence to support his position as required by MPEP §2144.03 (C). Such documentary evidence should be in the same field as the present invention, that is the field of on-line advertising.

Additionally, the Gerver reference also does not teach, suggest, or disclose dependent claim 42 which recites the system of claim 41, wherein the play script includes information indicating location placement of the advertisement on the display device such that the electronic advertisement cannot be scrolled past. One object of the invention is to ensure that the advertisement is seen. One way of accomplishing that is to include code that ensures the advertisement is locked to a certain area of the display device on which it is played. Thus, even if a user was able to scroll down a content page, the user would not be able to scroll past the advertisement because the advertisement is locked to a location on the screen, not to a location on the content page. This is unlike banner ads, which are locked to a location on the content page. Thus, the Applicant believes dependent claim 42 distinguishes over the Gerver reference.

Additionally, the Gerver references does not teach, suggest, or disclose an electronic advertisement wherein the advertisement is in a video format capable of

being played on the display device of the terminal as recited by dependent claim 44. The Gerver reference is directed to animation that requires the user's terminal to possess Gerver's own proprietary software program called Scene Manager. The Gerver reference does not disclose video advertisements as recited by dependent claim 44. Video advertisements may come in a variety of formats such as MPEG as mentioned in the specification of the present invention and that can be played using commonly available, commonly used plug-ins, but the animation of the Gerver reference requires its own separate proprietary program. Thus, the Applicant believes dependent claim 44 distinguishes over the Gerver reference.

The Alberts reference cannot make up for the deficiencies of the Gerver reference. While the Alberts reference teaches Internet advertising, it does not teach **an advertisement source configured to transmit an electronic advertisement to said terminal to be displayed on said display device through said communication network, said electronic advertisement containing moving objects; and**

a content source configured to transmit a main content and a play script to said terminal through said communication network, said main content being content other than advertising;

an advertisement play tracker, configured to receive a play-tracking message indicating the electronic advertisement has been shown, wherein execution of said play script by said terminal causes the electronic advertisement to be sent to the terminal, and the play script includes a timeline indicating an ending time of the electronic advertisement and causes the electronic advertisement to be removed from the display device at the ending time and the

play script sends a play tracking message to the advertisement play tracker around the ending time.

The Alberts reference is directed to banner ads whereas the present application is directed towards moving picture ads. Thus, the Alberts reference does not teach, disclose, or suggest an electronic advertisement having moving objects. For the same reason, Alberts does not teach, suggest, or disclose the play script having a timeline indicating an ending time of the electronic advertisement that causes the electronic advertisement to be removed at the ending time, nor sending a play-tracking message to an advertisement play tracker at the ending time. Banner ads do not have ending times.

Additionally, the Alberts reference does not teach, disclose, or suggest, having a content source separate from an advertising source, as recited by independent claim 41. Alberts teaches a web server that is also a content server. They are not separated as specified by independent claim 41. The separation of the content server and the advertising server frees up space on the content server to provide more data at a larger bandwidth. Thus, the Applicant believes independent claim 41 distinguishes over both the Gerver and Alberts references.

Furthermore, Alberts does not teach suggest or disclose the limitation of the play script including information indicating location placement of the advertisement on the display device as recited by dependent claim 42. Banner ads are located on the same layer as the main content; they are part of the website. Thus, contrary to the emphasis of the present invention, a user can scroll past banner ads. A user cannot scroll past an advertisement that is locked to a location on the display device, as recited in

dependent claim 42. Thus, the Applicant believes dependent claim 42 distinguishes over the Alberts reference.

Additionally, Alberts does not teach, suggest or disclose, advertisements that are in a video format as recited by dependent claim 44. Thus, the Applicant believes dependent claim 44 distinguishes over the Alberts reference.

Finally, Alberts does not teach, suggest, or disclose the play-tracking message including information indicating that the advertisement was displayed through completion, as recited by dependent claim 49. As stated before, banner ads do not have ending times. Therefore with banner ads, advertisement tracking can only indicate that an advertisement was served, not seen through completion. Thus, while online advertisers may pay for every hit a web page receives where the advertiser runs a banner ad, they are not necessarily paying for customers who see the ad. Customers may quickly jump to another web page, or may scroll down quickly and never see the ad. But with the invention of the present application, the advertiser can be sure that his ad ran through completion and was almost positively seen by a user when the play-tracking message includes information indicating that the ad played through completion. Thus, the Applicant believes dependent claim 49 distinguishes over the Alberts reference.

New claims 51, 61, and 71 all recite limitations similar to independent claim 41, and thus Applicant submits that such claims distinguish over the cited art for the same reasons as claim 1. Claims 42-50 and 82 depend directly or indirectly from independent claim 41, and thus Applicant submits that these claims distinguish over the cited art for the same reasons as claim 41. Claims 52-60 depend directly or indirectly

from independent claim 51, and thus Applicant submits that these claims distinguish over the cited art for the same reasons as claim 51. Claims 62-70 depend directly or indirectly from independent claim 61, and thus Applicant submits that these claims distinguish over the cited art for the same reasons as claim 61. Claims 72-81 depend directly or indirectly from independent claim 71, and thus Applicant submits that these claims distinguish over the cited art for the same reasons as claim 71.

Applicant believes that the foregoing amendments place the application in condition for allowance, and a favorable action is respectfully requested. If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles telephone number (213) 488-7100 to discuss the steps necessary for placing the application in condition for allowance should the Examiner believe that such a telephone conference would advance prosecution of the application.

Respectfully submitted,

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